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| APPLICATION NO.  | FILING DATE        | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |           |                |            |       |
|--|--------------------|--------------------------|---|------------------|-----------|----------------|------------|-------|
| 10/511,507   | 10/15/2004         | Jose Luis Castro Pineiro | T1573P  | 4195             |           |                |            |       |
| 210<br>MERCK AND CO., INC<br>P O BOX 2000<br>RAHWAY, NJ 07065-0907 | 7590<br>09/06/2007 |                          | <table border="1"><tr><td>EXAMINER</td></tr><tr><td>SAEED, KAMAL A</td></tr></table>                                  |                  | EXAMINER  | SAEED, KAMAL A |            |       |
| EXAMINER   |                    |                          |   |                  |           |                |            |       |
| SAEED, KAMAL A   |                    |                          |   |                  |           |                |            |       |
|  |                    |                          | <table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1626</td><td></td></tr></table>              |                  | ART UNIT  | PAPER NUMBER   | 1626       |       |
| ART UNIT   | PAPER NUMBER       |                          |   |                  |           |                |            |       |
| 1626   |                    |                          |   |                  |           |                |            |       |
|  |                    |                          | <table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>09/06/2007</td><td>PAPER</td></tr></table> |                  | MAIL DATE | DELIVERY MODE  | 09/06/2007 | PAPER |
| MAIL DATE  | DELIVERY MODE      |                          |   |                  |           |                |            |       |
| 09/06/2007   | PAPER              |                          |   |                  |           |                |            |       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/511,507

Applicant(s)

PINEIRO ET AL.

Examiner

Kamal A. Saeed

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-6 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/15/04;11/23/05;01/25/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***DETAILED ACTION***

Claims 11 and 12 have been cancelled. Therefore, claims 1-10 and 13 are currently pending in this application. Claim 13 is withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

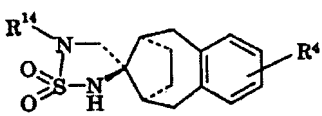
Note: Claims 8-10 were inadvertently omitted from the invention of Group I. These claims are now included with invention of Group I. The examiner regrets any inconvenience this may have caused.

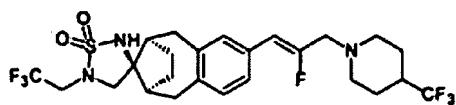
### **Information Disclosure Statement**

Applicant's Information Disclosure Statements, filed on October 15, 2004; November 23, 2005; and January 25, 2006 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

### **Response to Restriction**

Applicants' election of Group I, claims 1-10 (in part), drawn to the compounds

represented by formula (I), , and specific compound of,



, in response filed on August 03, 2007 is acknowledged.

Because Applicants did not distinctly and specifically point out the supposed errors in the

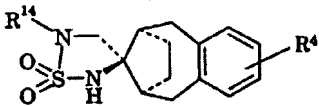
Art Unit: 1626

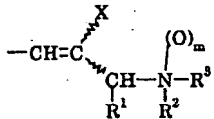
restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, the restriction requirement is deemed proper.

In accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims and method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*The scope of the invention of the elected subject matter is as follows:*

Compounds of formula I, , depicted in claim 1, wherein:

  $R^4$  is represents, an optionally substituted fused or non-fused aryl or heteroaryl;  $R^2$  and  $R^3$  together with the nitrogen to which they are attached form a monocyclic heterocyclic group;  $m$  is as defined; and  $X$  is as defined.

*The scope of the invention of the elected subject matter* have been extended to include the definition of the variables of  $R^1$  to represent as defined in claim 1;  $R^{14}$  as defined in claim 1 except that it doesn't represent a heterocyclic group.

Art Unit: 1626

As result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1-6 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as triazine, homopiperazinyl, thiomorpholinyl, propylaminyl etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 subclass 63(+) (thiomorpholine), class 540 subclass 450(+) (homopiperziny), class 544 subclass 180(+) (triazines), 548 subclass 400(+) pyrrolidines etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Claims 7-9 are also withdrawn because they are directed to non-elected subject matter.

#### **Claim Objections**

Claims 1-6 and 10 are objected to for containing non-elected subject matter.


#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Art Unit: 1626

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER